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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,243	06/24/2003	Ali Rezai	12637/30	5654
7590	02/06/2006		EXAMINER	
Kenyon & Kenyon Attn: Estelle Tsevdos One Broadway New York, NY 10004			JOHNSON, SHEVON ELIZABETH	
			ART UNIT	PAPER NUMBER
			3766	

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)
	10/603,243	REZAI ET AL.
	Examiner	Art Unit
	Shevon E. Johnson	3766

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 June 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 12 and 13 is/are allowed.
- 6) Claim(s) 1,2,6-8,10 and 11 is/are rejected.
- 7) Claim(s) 3-5, and 9 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/23/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

Specification

1. The disclosure is objected to because of the following informalities: On page 7 of the specification, paragraph [0033], line 7, "the electrodes 104" is numbered incorrectly and should be substituted for "the electrodes 545 ". Appropriate correction is required.

Drawings

2. The drawings are objected to because in the specification on page 9, paragraph [0040], line 10, applicant draws reader's attention to Fig. 10 where "the arrows indicate particular relevant treatment sites", yet in Fig. 10 arrows indicating particular relevant treatment sites are missing.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 6-8, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baudino et al. (U.S. Patent No. 6,353,762) cited by applicant, in view of Goldman et al. (U.S. Patent No. 6,969,388).

In regards to claims 1-2, 6-8, 10 and 11, Baudino et al. discloses a device comprising a cannula 22A and a plurality of leads 16-18, 920 having at least one electrode 16A-18A disposed thereon, opening 915, guide 905 (col. 2, lines 45-51; col. 4, lines 42-45 and 53-57; Figs. 3). Baudino et al. teaches the actuation of the leads but the specification lacks a clear description of the actuator mechanism (col. 6, lines 13-20). However, Goldman et al. discloses a device comprising a cannula 30 having a proximal end, a distal end 40, and a lumen 60 extending to at least the distal end, an actuator mechanism 76 at least partially disposed in the lumen of the cannula; a plurality of leads having at least one electrode 58 disposed thereon, the plurality of leads being coupled to the actuator mechanism to reciprocate between a retracted position wherein the plurality of leads are radially constrained within the lumen and an extended position wherein the plurality of leads deploy radially outwardly into the tissue (col. 8, lines 39-67 and col. 9, lines 30-32; Fig. 4). Therefore, it would have been obvious to one of ordinary skill in the art to modify Baudino et al. as taught by Goldman et al. to include a detailed description of the actuator mechanism in order to actuate the leads from the cannula into the tissue.

5. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baudino et al. (U.S. Patent No. 6,353,762) cited by applicant, in view of de la Rama et al. (U.S. Patent No. 6,029,091).

In regards to claims 1 and 2, Baudino et al. discloses a device for modulating neural tissue except a clear description of the actuator mechanism (col. 6, lines 13-20). However, de la Rama et al. discloses a device comprising a catheter 2 having a proximal end 4, a distal end 3, and a lumen 5 extending to at least the distal end, an actuator mechanism 7 or 8 at least partially disposed in the lumen of the cannula; a plurality of leads having at least one electrode 32 disposed thereon, the plurality of leads 21 being coupled

to the actuator mechanism to reciprocate between a retracted position wherein the plurality of leads are radially constrained within the lumen and an extended position wherein the plurality of leads deploy radially outwardly into the neural tissue (col. 4, line 52 – col. 5, line 22, Figs. 1, 2, 6 and 7). Therefore, it would have been obvious to one of ordinary skill in the art to modify Baudino et al. as taught by de la Rama et al. to include a detailed description of the actuator mechanism in order to actuate the leads from the cannula.

Allowable Subject Matter

6. Claims 3-5, and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 12-13 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shevon Johnson whose telephone number is (571) 272-2010. The examiner can normally be reached on M-F (8 a.m. - 4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shevon Johnson
Art Unit 3766



Robert Pezzuto
Supervisory Patent Examiner
Art Unit 3766